

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Biomira Inc.

§

Opposer,



Opposition No. _____

v.

07-30-2003

Application Serial No. 76/240,537

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Biomarin Pharmaceutical

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Publication Date: April 1, 2003

Applicant.

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NOTICE OF OPPOSITION

Opposer, Biomira Inc., a corporation of Canada, with a principal place of business at 2011-94 Street, Edmonton, Alberta, Canada T6N 1H1, believes it will be damaged by registration of the mark shown in Application Serial No. 76/240,537, and therefore opposes registration of this mark under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

Application Serial No. 76/240,537, for the mark BIOMARIN, was filed on April 10, 2001, for "assays, screening kits, devices, and equipment for scientific analysis and diagnosis of disorders and physiological processes; assays, screening kits, devices, and equipment for measurement of disease markers for scientific purposes," in International Class 1; and "pharmaceutical preparations for use in enzyme therapy; pharmaceutical preparations for use in treatment of genetic disorders; pharmaceutical preparations for use in burn and wound debridement or cleaning; pharmaceuticals for treatment of inflammation, infectious diseases and cardiovascular diseases; assays, screening kits, devices, and equipment for medical analysis and diagnosis of disorders and physiological processes; assays, screening kits, devices, and equipment for measurement of disease markers for medical purposes; carbohydrate inhibiting

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enzymes for use in disease treatment; fungal lytic enzymes for the treatment of fungal infections; pharmaceuticals for treatment of lysosomal storage diseases; pharmaceuticals for treatment of mucopolysaccharidoses; pharmaceuticals for treatment of carbohydrate-inhibiting enzyme disorders; proteins and enzymes for the production, purification and isolation of biologics for use in the treatment of medical conditions; biologics produced by recombinant DNA technology for use in the treatment of pathological medical conditions,” in International Class 5. The mark was published for opposition in the *Trademark Official Gazette* on April 1, 2003. Biomira Inc. timely obtained extensions of time to oppose out to July 30, 2003.

The grounds for opposition are as follows:

1. Opposer Biomira Inc., a Canadian corporation, has a place of business at 2011-94 Street, Edmonton, Alberta, Canada T6N 1H1.

2. Opposer, using the trade name BIOMIRA, is an established biotechnology company that has built a large and successful business in the biotechnology and health fields, engaging in, inter alia, research and development of various pharmaceutical preparations.

3. Opposer owns Application Serial No. 75/552,893, filed September 14, 1998, for the mark BIOMIRA, covering pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents, in International Class 5; manufacture services for others, namely manufacture of pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised

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primarily of reagents, in International Class 40; and pharmaceutical research in the fields of pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents, in International Class 42.

4. Opposer's Application Serial No. 75/552,893 was filed based on Section 1(b) and Section 44(e) of the Trademark Act, 15 U.S.C. §§ 1051(b) and 1126(e). At the time of filing, September 14, 1998, and at all times thereafter, Opposer has maintained a good faith intent-to-use its mark in commerce in connection with all of the goods and services identified in the application.

5. Applicant filed its intent-to-use application for BIOMARIN on April 10, 2001, for assays, screening kits, devices, and equipment for scientific analysis and diagnosis of disorders and physiological processes; assays, screening kits, devices, and equipment for measurement of disease markers for scientific purposes, in International Class 1; and pharmaceutical preparations for use in enzyme therapy; pharmaceutical preparations for use in treatment of genetic disorders; pharmaceutical preparations for use in burn and wound debridement or cleaning; pharmaceuticals for treatment of inflammation, infectious diseases and cardiovascular diseases; assays, screening kits, devices, and equipment for medical analysis and diagnosis of disorders and physiological processes; assays, screening kits, devices, and equipment for measurement of disease markers for medical purposes; carbohydrate inhibiting enzymes for use in disease treatment; fungal lytic enzymes for the treatment of fungal infections; pharmaceuticals for treatment of lysosomal storage diseases; pharmaceuticals for treatment of mucopolysaccharidoses; pharmaceuticals for

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treatment of carbohydrate-inhibiting enzyme disorders; proteins and enzymes for the production, purification and isolation of biologics for use in the treatment of medical conditions; biologics produced by recombinant DNA technology for use in the treatment of pathological medical conditions, in International Class 5.

6. Upon information and belief, Opposer's BIOMIRA application and use of the BIOMIRA trade name predates the Applicant's BIOMARIN application.

7. Upon information and belief, the assays, screening kits, devices, equipment and pharmaceutical preparations to be offered by Applicant under the BIOMARIN mark are closely enough related to the pharmaceutical preparations, manufacturing services and research services sold and/or intended to be sold by Opposer under the BIOMIRA mark as to be likely to lead to confusion.

8. Applicant's intended use of the mark BIOMARIN, for the goods noted above so nearly resembles Opposer's BIOMIRA mark for the products and services covered in its application, specifically, pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents; manufacture services for others, namely manufacture of pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents; and pharmaceutical research in the fields of pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of

cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents, as to be likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

9. The registration of Applicant's mark on the Principal Register would be inconsistent with Opposer's rights under its aforementioned application, and would be damaging to Opposer and its use of the trade name BIOMIRA.

WHEREFORE, Opposer prays that this opposition be sustained and that Application Serial No. 76/240,537 be refused registration.

Respectfully submitted,

Date: July 30, 2003

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July 30, 2003



Via Hand Delivery

07-30-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

BOX TTAB – FEE

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: *Opposition to Application Serial No. 76/240,537 (BIOMARIN) by Biomira Inc.*
Filed: April 10, 2001
Publication Date: April 1, 2003
Our Reference: 342.057/09804335

Dear Madam:

Enclosed is a Notice of Opposition (in triplicate) on behalf of Biomira Inc. against the application of Biomarin Pharmaceutical, Inc., designated Serial No. 76/240,537, for BIOMARIN.

Also enclosed is a check in the amount of \$600 to cover the filing fee. If the check is inadvertently not attached or if it is insufficient, the Commissioner for Trademarks is hereby authorized to charge the deposit account of Fulbright & Jaworski, LLP, Account No. 06-2375, Order No. 342.057/09804335. A duplicate copy of this letter is enclosed for billing purposes.

A Designation of Domestic Representative document will be forthcoming.

Also enclosed is a postcard which we ask be stamped by the Trademark Trial and Appeal Board to reflect the filing date of this Notice of Opposition and then be returned to the undersigned.

Very truly yours,


Mark Ungerman

MU/KD/bb
Enclosures